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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,495	07/15/2004	Lawrence Weekhar Lee		4494

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EXAMINER
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ROBINSON, KITO R

ART UNIT	PAPER NUMBER
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3692

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/710,495	<b>Applicant(s)</b> LEE, LAWRENCE WEEKHAR	
	<b>Examiner</b> KITO R. ROBINSON	<b>Art Unit</b> 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 7-10, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) 1-6, 11, 12 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-10, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the application filed on 15 July 2004.
2. Claims 7-10, 13 & 14 are currently amended
3. Claims 1-6, 11-12 and 15 are canceled.
4. Claims 7-10, 13 & 14 are currently pending and have been examined.
5. The rejection to claims 7-10, 13 & 14 have been updated to reflect the amendments.

### **Response to Arguments**

6. Applicant's arguments received on 02 May 2008 have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims.
7. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. However, in an effort to elucidate the applicability of the selected prior art, the Examiner has provided a riposte to the Applicant's arguments.
8. With regard to the limitations of claim 7, Applicant argues, "Ensel does not disclose a method for downloading, storing and displaying electronic statements in their unaltered original document format as provided by the statement issuer thereby retaining the fidelity and authenticity of the original statement." See the claim rejection below.

9. With regard to the limitations of claim 9, Applicant argues, "Neither Ensel nor Kolling discloses downloading, storing and displaying electronic statements in their unaltered original document format as provided by the statement issuer." See the claim rejection below.
10. With regard to the limitations of claim 8, Applicant argues, "Riley teaches certain transaction data can be generated into the e-statement automatically; however, it does not disclose automatic downloading of the entire statement in its original document format as provided by the issuer. See the claim rejection below.
11. With regard to the limitations of claim 10, Applicant argues, "Kolling discloses using automatic OCR to convert scanned images to PDF; however, it does not disclose method for employing OCR to extract data from statement encoded in document format provided by the issuer. See the rejection below.
12. With regard to the limitations of claims 13 & 14, Applicant argues, "Ensel and Kolling teach billers' capability to create statements with custom personalized messages having the same "look-and-feel" as paper statements based on customer characteristics; however, they do not disclose accessing, downloading, importing, exporting, and storing electronic data provided by the issuers and associating these data with the corresponding statements in their original document format. Applicant therefore respectfully asserts that Claim 10 is allowable over Kolling.

#### **Claim Rejections - 35 USC § 112**

13. The Examiner makes note of the Applicant's response to claim 9, 13 & 14 rejections and respectfully rescinds the 35 USC § 112 rejections.

#### **Claim Rejections - 35 USC § 103**

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. Claims 7 & 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogawa et al. US Patent Number 5,608,874, hereafter Ogawa in view of Kolling et al. 5,963,925, hereafter Kolling.

**As per claim 7 & 9,**

Ogawa discloses:

- *downloading the electronic statements that have not been previously downloaded in the original document format provided by the issuer (see at least column 14, lines 18-21: **Once data 118 is received by Provider Section 10, Main Processing Section 20 stores and archives the data provided by Provider Section 10 in it's original, Data Provider's Format.**)*
- *storing the downloaded electronic statements in the original document format provided by the issuers to the user specified electronic data storage device (see at least column 14, lines 21-25: **"Storage media employed by Main Processing Section may include magnetic and non-magnetic storage devices including, but not limited to hard disks, tapes, magneto-optical disks, compact disks and memory chips."**)*
- *downloading and storing electronic statement data in formats provided by the issuers (see at least column 14, lines 18-21: **Once data 118 is received by Provider Section 10, Main Processing Section 20 stores and archives the data provided by Provider Section 10 in it's original, Data Provider's Format.**)*

Ogawa dose not disclose the following however Knolling does:

- *displaying the retrieved electronic statements in the original document format provided by the issuers (See at least Column 34 line 60-63: For presentation of the information to a customer, any of a variety of media may be used to transmit and display the information from a CSP to the customer.”)*

It would have been obvious to one of ordinary skill in the art at the time of the invention to [combine/modify] the method of Ogawa with the technique of Knolling because to eliminate time-consuming and error-producing manual data re-entry (as taught in Ogawa Column 1, lines 20-22).

**As per claim 8**

Ogawa discloses:

- *automatically sending instructions to user specified issuers to check for electronic statements that have not been downloaded previously to the user specified electronic data storage device and automatic downloading of these statements (see at least Column 25, Lines 24-27: “After PostProcessor 601 has completed all of its tasks, the end result is that transactions have been automatically entered into Subscriber’s Application Software 620 and have been verified and validated...”)*

**As per claim 10,**

Ogawa discloses:

- *optical character recognition of the information contained within the stored documents (see at least Column 27 line 25-39: “When a paper document such as a bank statement is transmitted by a conventional fax machine, a graphic file of the printed data is being sent...perform character recognition, such as by OCR (Optical Character Recognition) and/or ICR (Intelligent Character Recognition)).*

**As per claim 14**

Ogawa discloses

- *associating the electronic statement data provided by the issuers with their corresponding statement in the original document format (see at least Column 18, lines 28-31: “In one embodiment, PrepServer Software 354 recalls from the internal database containing the successful transmission data receipts which MPS Incoming Data Box 355 the data file originally arrived in.”)*

17. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ogawa & Kolling in view of Kablesh et al US 2006/0200754 A1, hereafter Kablesh.

**As per claim 13,**

Ogawa & Kolling discloses the limitations as shown in the rejection of Claim 7 & 9 above. Ogawa & Kolling does not disclose the limitation of *accessing, downloading, importing, exporting, and storing electronic documents statement data provided by the issuers and organizing, archiving, and retrieving such data*. However, Kablesh, in at least Paragraph 0011 & 0012 discloses “store a set of information for the electronic form; receive a request for access to the electronic form; retrieve the set of information for the electronic form; place the retrieved set of information into the electronic form; display the electronic form; receive updated information in the electronic form; and store the updated information in the data storage in the set of information for use in filling out the electronic form.” “...format the requested electronic form information in a format specified by the data recipient” = organizing.

It would have been obvious to one of ordinary skill in the art at the time of the invention to [combine/modify] the method of Ogawa with the technique of Knolling because to eliminate time-consuming and error-producing manual data re-entry (as taught in Ogawa Column 1, lines 20-22).

**Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Kito Robinson** whose telephone number is **571.270.3921**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Kambiz Abdi** can be reached at **571.272.6702**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**P.O. Box 1450**

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or faxed to **571-273-8300**.

Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window:**

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Alexandria, VA 22314.

/Kito R Robinson/Examiner, Art Unit 3692

10 June 2008

/Harish T Dass/

Primary Examiner, Art Unit 3692